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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,892	10/13/2000	Phillip Koh-Kwe Hsu	74622-014	8983

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PROSKAUER ROSE LLP
PATENT DEPARTMENT
1585 BROADWAY
NEW YORK, NY 10036-8299

EXAMINER

CHANDLER, SARA M

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/687,892	Applicant(s) HSU ET AL.	
	Examiner SARA CHANDLER	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/10/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27,28,30-34,36-38,41-43,45 and 46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27,28,30-34,36-38,41-43,45 and 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's arguments and request for continued examination of application 09/687,892 (10/13/00) filed on 11/10/08.

The restriction by original presentation as set forth in the Office action mailed on 7/10/08, has been reconsidered in view of applicant's amendments filed with the request for continued examination on 11/10/08. The restriction requirement is hereby withdrawn as the claimed inventions are no longer considered patentably distinct.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claim Interpretation

1. In determining patentability of an invention over the prior art, all claim limitations have been considered and interpreted as broadly as their terms reasonably allow. See MPEP § 2111.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Pruter*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See MPEP § 2111.

2. All claim limitations have been considered. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art. The

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following language is interpreted as not further limiting the scope of the claimed invention. See MPEP 2106 II C.

Language in a method claim that states only the intended use or intended result, but the expression does not result in a manipulative difference in the steps of the claim. Language in a system claim that states only the intended use or intended result, but does not result in a structural difference between the claimed invention and the prior art. In other words, if the prior art structure is capable of performing the intended use, then it meets the claim.

Claim limitations that contain statement(s) such as “*if, may, might, can could*”, as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.

Claim limitations that contain statement(s) such as “*wherein, whereby*”, that fail to further define the steps or acts to be performed in method claims or the discrete physical structure required of system claims.

USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter. See MPEP § 2106 II C.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

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- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

See MPEP § 2106 II C.

3. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27-28, 30-34, 36-38 and 41-43 and 45-46 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 27, 37 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, essential steps and/or essential structural cooperative relationships of elements such omission amounting to a gap between the elements, the steps and/or the necessary structural connections . See MPEP § 2172.01. The omitted elements, steps and/or structural cooperative relationships are:

It is unclear how the invention is deciding which messages from the plurality of messages will be delayed for receipt of manual input.

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The fact that the messages are “financial messages” is nonfunctional descriptive material. Nothing is distinct for the process or system because the messages are financial in nature. Need to put function as to what is being reviewed.

Should the user interface be a component of the system similar to the “processor and memory”? It appears like the interface could be a part of any system and not necessarily a part of the invention as claimed.

Dependent claims are further rejected based on the same rationale as the claims from which they depend.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 27-28, 30-34, 36-38 and 41-43 and 45-46 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bachman, US Pat. No. 6,315,196.

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Re Claims 27-28, 30-34 and 36: Bachman discloses computer system that delivers financial messages to individual clients comprising:

a processor and memory (Bachman, col. 1, lines 27-34; col. 1, lines 60+ - col. 2, line 5; col. 2, lines 29-40; col. 3, lines 11-33; col. 3, lines 55+ - col. 5, line 20; col. 6, lines 25+ - col. 9, line 26; col. 9, lines 50+ - line 14; col. 13, line 44+ - col. 14, line 15; col. 14, line 59+ - col. 15, line 10 Inherency The component are inherent to the system disclosed in Bachman. The evaluation and storing or enrollment information for example requires a processor and memory. The manual input by a customer service representative requires a user interface. Financial Message – Since the messages pertain to a credit account, they may interpreted as financial messases);

the memory storing a messaging system that further comprises a registration system module, a message creation system module and a intervention system module (Bachman, col. 1, lines 27-34; col. 1, lines 60+ - col. 2, line 5; col. 2, lines 29-40; col. 3, lines 11-33; col. 3, lines 55+ - col. 5, line 20; col. 6, lines 25+ -col. 9, line 26; col. 9, lines 50+ - line 14; col. 13, line 44+ - col. 14, line 15; col. 14, line 59+ - col. 15, line 10

Inherency The component are inherent to the system disclosed in Bachman. The evaluation and storing or enrollment information for example requires a processor and memory. The manual input by a customer service representative requires a user interface. Financial Message – Since the messages pertain to a credit account, they may interpreted as financial messases):

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the processor executing the registration system module that registers in the memory user preferences that determine financial messages to deliver to individual clients (Bachman, Figs. 1,5 and 9; col. 1, lines 27-34; col. 1, lines 60+ - col. 2, line 5; col. 2, lines 29-40; col. 3, lines 11-22; col. 3, lines 55+ - col. 4, line 21; col. 4, lines 51+-col. 5, line 20; col. 6, lines 43+-col. 7, line 37 Financial Message – Since the messages pertain to a credit account, they may interpreted as financial messases);

the processor executing the message creation system module that automatically creates financial messages in accordance with the registered user preferences for the individual clients and delivers the automatically created financial messages to the individual clients after a predetermined delay (Bachman, Figs. 1,5 and 9, col. 3, lines 23-33; col. 4, lines 22-50; col. 4, lines 66+- col. 5, line 19; col. 6, line 43+- col. 6, line 62; col. 7, line 38+ - col. 10, line 14; col. 14, line 59+ - col. 15, line 10 Financial Message – Since the messages pertain to a credit account, they may interpreted as financial messases);

the processor executing the intervention system module that-during the delay, presents the-at least one financial message from among the automatically generated financial messages through a user interface, receives user commands input through the user interface to modify the at least one financial message, and modifies content of the at least one financial message according to user commands, resulting in a modified financial message that is delivered to the individual client by the processor executing the message creation system module (Bachman, Figs. 1,5 and 9, col. 13, line 44+ - col.

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14, line 15 Financial Message – Since the messages pertain to a credit account, they may interpreted as financial messases).

Alternatively,

Bachman fails to explicitly disclose wherein the messages are financial messages (Financial Message – The messages also be interpreted as being drawn to the status of the customer and/or their account and thus are not financial in nature)..

Regarding wherein the messages are financial messages.

Official Notice is taken that is old and well-known to provide systems directed to the delivery of financial messages. Thus, to provide wherein the messages are financial message would have been old and well known at the time the invention was made.

Analogous Art It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Bachman addresses the same problem to be solved which is the manual modification of messages prior to delivery..

Nonfunctional The type of message has no bearing on the positively recited steps or acts performed or structure of the system claimed.

Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter. Seem MPEP 2106.01, II.

It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to modify the teachings of Bachman to provide wherein the messages are financial messages.

Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Re Claims 37-38 and 41: Bachman discloses a computer system that provides delivers financial messages to individual clients comprising:

a processor and memory (Bachman, col. 1, lines 27-34; col. 1, lines 60+ - col. 2, line 5; col. 2, lines 29-40; col. 3, lines 11-33; col. 3, lines 55+ - col. 5, line 20; col. 6, lines 25+ - col. 9, line 26; col. 9, lines 50+ - line 14; col. 13, line 44+ - col. 14, line 15; col. 14, line 59+ - col. 15, line 10 Inherency The component are inherent to the system disclosed in Bachman. The evaluation and storing or enrollment information for example requires a processor and memory. The manual input by a customer service representative requires a user interface. Financial Message – Since the messages pertain to a credit account, they may interpreted as financial messases);

the memory storing a messaging system that further comprises a message creation system module and an intervention system module (Bachman, col. 1, lines 27-34; col. 1, lines 60+ - col. 2, line 5; col. 2, lines 29-40; col. 3, lines 11-33; col. 3, lines 55+ - col. 5, line 20; col. 6, lines 25+ -col. 9, line 26; col. 9, lines 50+ - line 14; col. 13, line 44+ - col.

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the processor executing the message creation system module that automatically creates financial messages and delivers the automatically created financial messages to the individual clients after a predetermined delay (Bachman, Figs. 1,5 and 9, col. 3, lines 23-33; col. 4, lines 22-50; col. 4, lines 66+- col. 5, line 19; col. 6, line 43+- col. 6, line 62; col. 7, line 38+ - col. 10, line 14; col. 14, line 59+ - col. 15, line 10 Financial Message – Since the messages pertain to a credit account, they may interpreted as financial messases);

the processor executing the intervention system module that during the delay, presents t-he at least one financial message from among the automatically generated financial messages through a user interface receives user commands input through the user interface to modify the at least one financial message, and modifies content of the at least one financial message according to the user commands, resulting in a modified financial message that is delivered to the individual client by the processor executing the message creation system module (Bachman, Figs. 1,5 and 9, col. 13, line 44+ - col. 14, line 15 Financial Message – Since the messages pertain to a credit account, they may interpreted as financial messases).

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Analogous Art It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Bachman addresses the same problem to be solved which is the manual modification of messages prior to delivery..

Nonfunctional The type of message has no bearing on the positively recited steps or acts performed or structure of the system claimed.

Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter. See MPEP 2106.01, II.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Bachman to provide wherein the messages are financial messages.

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Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Re Claims 42, 43, 45 and 46: Bachman discloses computerized method for delivering financial messages to individual clients comprising:

automatically creating financial messages for delivery to the individual clients (Bachman, Figs. 1,5 and 9, col. 3, lines 23-33; col. 4, lines 22-50; col. 4, lines 66+- col. 5, line 19; col. 6, line 43+- col. 6, line 62; col. 7, line 38+ - col. 10, line 14; col. 14, line 59+ - col. 15, line 10 Financial Message – Since the messages pertain to a credit account, they may interpreted as financial messases);

delaying delivery of at least one of the financial messages to an individual client (Bachman, Figs. 1,5 and 9, col. 13, line 44+ - col. 14, line 15 Financial Message – Since the messages pertain to a credit account, they may interpreted as financial messases);

and during the delay, presenting the at least one financial message from among the automatically generated financial messages through a user interface receiving user commands input through the user interface to modify the at least one financial message; and modifying content of the at least one financial message according to the user commands, resulting in a modified financial message (Bachman, Figs. 1,5 and 9,

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col. 13, line 44+ - col. 14, line 15 Financial Message – Since the messages pertain to a credit account, they may interpreted as financial messases);

and delivering the modified financial message to the individual client (Bachman, Figs.

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Alternatively,

Bachman fails to explicitly disclose wherein the messages are financial messages (Financial Message – The messages also be interpreted as being drawn to the status of the customer and/or their account and thus are not financial in nature)..

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Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art. Thus, the claimed subject matter likely would have been obvious under KSR. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARA CHANDLER whose telephone number is (571)272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC
/JAGDISH N PATEL/
Primary Examiner, Art Unit 3693